

REMARKS

1. Support for Amendments

All amendments were made either to update the status of co-pending applications, or to further limit or clarify the claims. Application Serial Number 09/246,525 is canceled because it is now abandoned. The Applicants submit that the amendments do not constitute new matter.

2. Claim status

Claims 1-11, 13, and 15-16 are currently pending.

3. Claim Rejections under 35 U.S.C. §112, first paragraph

(a) The Action rejected claims 1-16 under 35 U.S.C. §112, first paragraph, based on the assertion that the specification, while being enabling for a method for treating alopecia, does not enable for a method for preventing alopecia.

The Applicants respectfully traverse the rejection. The specification provides adequate enablement for a method comprising administering recited compounds for preventing alopecia (see Example 1 on page 18, for preventing chemotherapy-induced alopecia). However, solely in order to expedite prosecution of the instant application, the Applicants have amended claim 1 to cancel “or preventing” as requested by the Action. The Applicants thus respectfully request the rejection be withdrawn.

(b) The Action rejected claims 2-4, and 6-9 under 35 U.S.C. §112, first paragraph, for lacking adequate written description for sequence having at least 3, 4, 5, or 6 contiguous amino acids of the sequence SEQ ID NO:41.

The Applicants respectfully traverse the rejection. It is stated in MPEP that to satisfy the written description requirement, "...a patent specification must describe the claimed invention in sufficient detail that one skill in the art can reasonably conclude that the inventor had possession of the claimed invention." (MPEP §2163) The guidelines for the examination under written description put the initial burden to the Examiner: "The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims." (MPEP §2163 II. A.) The sequence having at least 3, 4, 5, or 6 contiguous amino acids of the sequence SEQ ID NO:41 is supported by the specification on, for instance, page 8, line 28 through page 9, line 19: " The active agents of particular interest in accordance with the present invention comprise a sequence of at least three contiguous amino acids of groups R¹-R⁸ in the sequence of general formula I..." (page 8, lines 28-30), and " In alternate embodiments, the active agents comprise a sequence of at least four, five, six, or seven contiguous amino acids of group R¹-R⁸ in the sequence of general formula I." (page 9 lines 15-17). One of skill in the art would be able to determine the metes and bounds of the claimed invention, and would conclude that the Applicants have the possession of the invention. The Applicants thus respectfully request the rejection be withdrawn.

4. Claim Rejections under 35 U.S.C. §112, second paragraph

The Action rejected claims 1-11, 13 and 15-16 under 35 U.S.C. §112, second paragraph, for recitation of the allegedly indefinite phrase "amount effective for treating". The Action asserted that it is not clear whether "amount effective for treating" means full treatment or partial treatment.

The Applicants respectfully contend that one of skill in the art would be able to determine the effective amount of recited compounds for treating alopecia based on the teaching of the specification,

and thus the phrase "amount effective for treating" is not indefinite. However, solely in order to expedite prosecution of the current application, the Applicants have amended claim 1 to cancel the phrase "amount effective for treating" as requested by the Action. The Applicants further submit that the amendment does not in any way limit the scope of claims, which includes both full treatment and partial treatment. For example, the specification defines "treating alopecia" to mean the ability to cure, or reduce one or more clinical symptoms of alopecia (page 5, lines 29-30). Based on the foregoing, the Applicants respectfully request withdrawal of the rejection.

If the Examiner believes that a telephone or personal interview would expedite prosecution of the instant application, the Examiner is invited to call the undersigned attorney at (312) 913-2106.

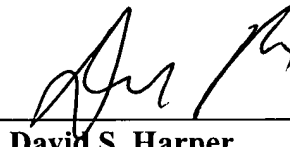
Respectfully submitted,

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Date:

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